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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,969	07/28/2006	Peter Kern	5707-0102PUS1	9996
2292 7590 02/24/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
TAWFIK, SAMEH				
ART UNIT		PAPER NUMBER		
3721				
NOTIFICATION DATE		DELIVERY MODE		
02/24/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/553,969

**Applicant(s)**

KERN, PETER

**Examiner**

Sameh H. Tawfik

**Art Unit**

3721

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date 20091103
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “holding device having a main surface for supporting the envelope during insertion of the sheets into the envelopes” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-6, 8-11, 13, 25, 26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kern (U.S. Patent No. 5,251,425).

Kern discloses a device for inserting sheets into an envelope, comprising a) a holding device (Figs. 1 and 5-7; via package trap 13 and fixed plates/hold down elements 14 and 15) having a main surface for supporting the envelope (surfaces of 14 and 15; envelope 3) during insertion of the sheets into the envelopes (Figs. 5 and 6; via holding down member/package trap 13); b) transport members (via 33 and 34) for feeding the sheets to be inserted to the holding device (13); c) a feed device (Figs. 5-7; via 15, 19, and 20) for feeding the envelope (3) to the holding device (13), along a feed direction; and d) a removal device (via 20, 21, 43, and 44) for removing the filled envelope from the holding device along a removal direction; characterized in that e) the main surface of the holding device (via 14 and 15) has a fixed orientation relative to the feed device and to the removal device and maintains the same fixed orientation during feeding and removing of the envelope respectively in the feed and removal direction (via 14 and 15 are fixed when positioned at the right position to operate with either the feed device and/or the removal device), the feed device (15, 19, and 20) and the removal device (20, 21, 43, and 44) are arranged relative to the main surface of the holding device (13 and 16) in such a manner that a first angle between the feed direction and a main surface of the holding device (13) and a second angle between the removal direction and the main surface of the holding device (13) the first and second angles being different from each other, see for example (Figs. 1 and 5-7).

Regarding claim 2: characterized in that the removal device is arranged relative to the holding device (13) in such a manner that the main surface of the holding device (13) is permanently parallel to the removal direction (via 13 is parallel to removing direction of the package when moved between 20, 21, 43, and 44, see for example Fig. 7).

Regarding claim 3: characterized in that the feed device comprises a guide element (via 15 and 16) with a discharge point, the guide element being convex at its discharge point.

Regarding claim 5: characterized in that the holding element (13) is formed by a pocket onto which the envelope can be pulled (Fig. 8).

Regarding claim 6: characterized in that the removal device comprises a first conveying device with a first, lower pressing roll (via roller rotating belt 43) and a second, upper pressing roll (via 21, 20, and 59), the second pressing roll (20) being pressed resiliently against the first pressing roll (via against the roller rotating belt 43).

Regarding claim 8: characterized by a safeguard for the envelope, for preventing a premature removal of the envelope from the holding device, see for example (Figs. 1 and 8; via 13).

Regarding claim 9: characterized in that the removal device comprises a take-off roll (via rollers driving and rotating the take off belts 43 and 44) with a segment for grasping the filled envelope which is to be removed.

Regarding claim 10: characterized in that all of the transport elements for the envelopes are driven by a single motor (Fig. 1; the entire enveloping unit is driven by motor 47).

Regarding claim 11: characterized in that the feed device has a segment roll (Fig. 1; via 8 and 9) for pulling the envelope off from a stack, with a rolling segment (10) for fully pressing

open a flap of the envelope, and a transport segment (11) for transporting the envelope.

Regarding claim 13: characterized in that the rolling segment (10) and the transport segment (11) are formed by claws which are arranged on a common rotational axle, see for example (Fig. 1; via both rollers 10 and 11 rotating on same axis).

Regarding claims 25 and 26: the transport members are configured to feed the sheets in a sheet transport direction parallel to the main surface of the holding device, see for example (Fig. 5; via direction of traveling sheets 38 parallel to member 13); and the transport members (via 33 and 34) are configured to push the filled envelope in the removal direction by acting on the sheets, see for example (Figs. 5-7).

Regarding claim 27: the holding device is non-pivoting (via fixed plate 16 is non-pivoting).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kern (U.S. Patent No. 5,251,425).

Regarding claim 4: Kern discloses that the guide element (15 and 16) is formed by a curved guide plate.

Kern does not disclose that a use of vacuum device on the3 guide plate. However, the examiner takes an official notice that such use of vacuum on guiding plate in the envelope filling

device is old, well known, and available in the art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Kern's device by the use of vacuum guiding plate, as a matter of engineering design choice, in order to gain more control of the envelope while guiding it through the feeding station and avoid any machine jam.

Regarding claim 7: Kern discloses that the feed device comprises a second conveying device with an upper pressing roll (19) and a lower pressing roll (20).

Kern does not disclose that the feed device is arranged below the removal device nor the first pressing roll of the first conveying device is the same as the upper pressing roll of the second conveying device.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Kern's device by having that the feed device is arranged below the removal device and the first pressing roll of the first conveying device is the same as the upper pressing roll of the second conveying device, since it has been held that rearranging parts of an invention involves only routine skill in the art. In *re Japikse*, 86 USPQ 70. *Note that Kern discloses the upper pressing roller of the first conveying device is the same as of the lower pressing roller of the second conveying device.*

Regarding claim 12: Kern does not disclose that the segment roll is designed in such a manner that a first coefficient of friction of a surface of the rolling segment is smaller than a second coefficient of friction of a surface of the transport segment.

However, as Kern discloses the segment roll and transport segment, therefore having the segment roll with smaller coefficient friction than the surface of the transport segment is just a matter of engineering design choice.

***Response to Arguments***

Applicant's arguments with respect to claims 1-13 and 24-27 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is 571-272-4470. The examiner can normally be reached on Tuesday - Friday from 9:00 AM to 7:30 PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sameh H. Tawfik/  
Primary Examiner, Art Unit 3721